
IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

No. 11642

REFRIGERATION ENGINEERING, INC., a Corporation,
Appellant,
vs.

YORK CORPORATION, a Corporation,
Appellee,
and

YORK CORPORATION, a Corporation,
Appellant,
vs.

REFRIGERATION ENGINEERING, INC., a Corporation,
Appellee.

REPLY BRIEF ON BEHALF OF YORK CORPORATION

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Reply Brief on Behalf of York Corporation

In its main brief Refrigeration states, and we agree, that the McAdam claims are for a combination, one of the elements of which is "a refrigerated space". But Refrigeration insists that this term must be "construed as limited to a refrigerated space constantly maintained below the freezing point of water" (Br. p. 60). This construction is referred to throughout the brief, when considering the McAdam alleged invention (pp. 2, 60), or in distinguishing the prior art (pp. 29, 35, 38, 45, 47, 50).

The refrigerated space is an important part of the combination, for Refrigeration attempts to distinguish the

claims over the prior art upon the ground that in McAdam the refrigerated space is “constantly maintained below freezing.”

Even if that limitation be read into the claims,

1. York has not infringed, because it has not made, used or sold any refrigerated space, whether or not “constantly maintained” below freezing, and there is no proof of any such manufacture, use or sale (York Br. pp. 67-8); and

2. The patent is invalid for lack of invention (York Br. pp. 56-67); and

3. The patent is anticipated by prior uses, a prior sale and prior patents conforming exactly to this interpretation (York Br. pp. 16-53).

But it is York’s contention (Br. pp. 13 to 15) that the McAdam patent was not issued for any such invention as is now claimed by Refrigeration, because

(a) the Patent Office specifically refused to allow claims which incorporated the limitation Refrigeration now asserts, and McAdam acquiesced in the deletion of this limitation; and

(b) the proposed limited construction of the claims in effect turns these apparatus claims into method of use claims, since “constantly maintaining” below freezing is a function of operation and not a physical thing. Since McAdam asked for method claims, but cancelled them during the prosecution of the application, there was an abandonment of such claims which cannot now be recaptured.

Since such a limitation can not be read into the claims, there is no basis for claiming that McAdam differs from the prior uses on this ground. Each of the installations has all the physical elements specified in the McAdam claims.

In the comments which follow upon Refrigeration’s Main Brief we have used its system of paragraph numbering.

I. The McAdam Patent Does Not Involve Invention

Since York's Main Brief (pp. 56-67) completely meets Refrigeration's argument (pp. 15-27) on the question of invention, we will here merely comment briefly upon some of the evidence Refrigeration erroneously contends supports its position.

Refrigeration contends that the brine method of defrosting was the closest approach to the McAdam invention; that the horrible example of brine defrosting at the Haslett Warehouse shows the great superiority of water defrosting, and therefore, presumably, that invention resides in McAdam's patent (pp. 15-6).

The argument is unsound first because the single example of the use of brine relied upon by Refrigeration was not used with a comparable type installation. The Haslett installation was of the exposed bare pipe type (R. 177) whereas McAdam's device is to be used with the enclosed coil unit type. A comparison of the two is meaningless. A much fairer comparison would be between McAdam's device and the typical brine defrosting system used successfully with the enclosed coil unit sold for years by York and still sold by it (R. 1016-7).

Moreover, the attempt to defrost at the Haslett Warehouse was far from the usual or typical brine defrosting operation. The great mass of exposed bare pipe at Haslett had never previously been completely defrosted, and was therefore so completely covered over with ice that there was very little space between the pipes (R. 178, 179). Even Refrigeration's manager testified "it is very bad practice" to let ice accumulate on the coils (R. 97). Obviously under such conditions when an attempt was made to defrost with brine, the operation was expensive and took a long time. As this was the only experience which the Haslett operator, Payne, had had with brine defrosting (R. 179), he was not familiar with the compact, enclosed, refrigerating units sold by York and others for many years prior to McAdam, which were equipped with continuous or intermittent brine defrosting. These are

shown in the drawings, Pl. Exs. 108-10 (R. 1313-5) and Exhibit C attached to the stipulation Def. Ex. CC (R. 1535). Such units defrosted in two to five minutes (R. 1017).

There is no question that brine was an accepted method of defrosting. Refrigeration's witness Ruppright suggests brine defrosting in his article (Def. Ex. Z, R. 1512). Counsel for York offered to show the Court a continuous brine spray unit in Los Angeles, but the offer was refused (R. 233). The fact that no intermittent brine spray units were available in Los Angeles attests to nothing, except perhaps that continuous brine spray was more popular in Los Angeles than was intermittent brine spray.

But, secondly, the argument is wholly fallacious because the closest approach in the prior art to McAdam was not brine, but water defrosting. There can be absolutely no question that it existed. It was disclosed in the prior patents and it was used in the prior uses proved in this case. Refrigeration's main contention seems to be that it was not used in a refrigerated space "constantly maintained" below freezing. As we have pointed out, this is not the fact and, even if it were, it would make no difference for the patent claims can not be limited in this respect.

Ia. "Long Felt Want."

That there was no "long felt want" is shown in York Main Brief, pp. 59-60.

The articles referred to by Refrigeration (pp. 19-23) do not support its position.

(a) *The Consley Article* (R. 1509):

This article relates to various methods of defrosting coils of the *exposed bare pipe* type arranged around the wall or ceiling of the refrigerated space. The fact that water defrosting is mentioned by Consley shows that such defrosting was not new. But that he thought this method had objections for defrosting *exposed bare pipe* is completely without significance to this case and is certainly not surprising, for in the nature of things water defrosting was then and is now utterly unsuitable for installations having exposed bare pipe on walls or ceilings. There is

no evidence that water defrosting is ever used today for such installations. The objections Consley made to water defrosting would not apply to defrosting concentrated enclosed coils.

Far from proving that there was no satisfactory means of defrosting and therefore there was a "long felt want", this Consley article shows that the hot gas method of defrosting was a common and satisfactory one (R. 1510-1511) which it still remains today (R. 1020).

(b) *The Ruppright Article* (R. 1512):

This article not only does not prove a "long felt want", but describes numerous successful methods of defrosting (R. 1513-6, par. 10-20) many of which are used today more commonly than water defrosting (R. 1020, 1031-2). The author lays particular emphasis on gas defrosting which he states "is very efficacious" (R. 1514, par. 17). His comment that water defrosting could be used "were it not for the trouble caused by water freezing in the piping during regular operation" (R. 1512) can carry little weight, for he admitted on cross-examination that he had never tried defrosting "where there was a spray head over the coils," (R. 144) nor did he have any knowledge of the use of water defrosting in the Gayley plants or at Yambill or Indianapolis (R. 143-4). He also was apparently not familiar with the common plumbing practice of draining standing water from pipes in a freezing zone, nor with the ordinary valve means for doing this.

It is significant that although Ruppright was called as a witness by Refrigeration, he did not testify that there was any "problem of satisfactorily defrosting" as claimed by Refrigeration.

(c) *The York Manual* (R. 1498):

The statement contained in this manual that when using gas defrosting "the drain line must be omitted as it would be frozen shut", proves nothing as to York's views of the practicability of water defrosting. The manual was not talking about water defrosting. Obviously in gas defrost-

ing there would be no large or sudden flow of water as in water defrosting to sweep the ice and frost away through a drain before it has a chance to clog the drain. The statement in this manual undoubtedly applies as well today to gas defrosting as when it was made. This manual proves nothing with respect to a "long felt want" for water defrosting or for a satisfactory defrosting method. All it indicates is the proper equipment for gas defrosting.

Ib. Scepticism of Unqualified Witnesses.

Refrigeration refers to scepticism on the part of "the refrigeration industry" and initial doubt of "qualified refrigeration experts" (pp. 23-24). As discussed on pages 62 to 66 of our Main Brief, Refrigeration's attempt to introduce hearsay testimony and the testimony of a few unqualified witnesses as to their "surprise" at water defrosting, is not proof as to the attitude of the "industry" and in no way supports the inventive character of the McAdam claims.

The matter of the guarantees which were given to a few early purchasers is considered in York's brief at p. 65.

Ic. Refrigeration's Sales Do Not Support the Claim of Invention.

Refrigeration's arguments on this point (pp. 25-27) are completely answered on pages 66 and 67 of York's brief.

II. The Patent Was Anticipated.

Ila. By Prior Use of Gayley Dry Blast Installations.

Refrigeration attacks the Gayley dry blast systems on the grounds that

(a) they were not self-draining, and

(b) that the coils were not located in a space "constantly maintained" below the freezing point of water (pp. 28-33). As to these points, the evidence clearly establishes the contrary (York pp. 25-28), but the significant thing is

that even Refrigeration *does not deny the existence and operation of these three water defrosting installations*, which between them operated from 1906 to 1928.

(a) Every one of the witnesses who was connected with the operation of the Gayley dry blast systems testified that they were self-draining (Brandt R. 335, 344; Kennedy R. 365-6; Harkins R. 389; Gaide R. 565-7; Tominac R. 510; Mueller R. 580, 595). Refrigeration attempts to throw doubt on this uncontradicted evidence by reference to the drawings of these systems which show the spray pipes to be substantially horizontal. Obviously drawings on such a small scale as these would not show any slight inclination which might be required for drainage, as pointed out by the witness Kennedy (R. 376): "When they put a pipe in like that, they put it on a little elevation. Probably on a drawing like that, they would not show it". Moreover, as explained on pages 19, 22 and 26 of York's Main Brief, these systems would have drained whether the spray pipes were horizontal or not.

(b) Refrigeration contends that the Gayley installations do not anticipate because they "were not located in a space constantly maintained below the freezing point of water" and that McAdam's invention is not anticipated unless the space is "maintained *constantly* below the freezing point of water" (p. 29; emphasis theirs).

The proof is clear and uncontradicted that during operation of the Gayley installations the refrigerating chambers were below freezing (York Br. p. 25). It is inevitable that this condition continued during at least a portion of the defrosting period because the warm outside air was excluded from the single chamber being defrosted and the accumulated mass of ice and frost would continue to cool the space (York Br. p. 26). It is immaterial whether such a condition existed the entire time of defrosting, any more than it does within the refrigerating unit of McAdam (R. 180-1). If the water was exposed to freezing temperatures for any substantial time the "problem" existed as much as if the freezing temperature were "constantly

maintained.” However, in the Gayley installations the water pipes passed through chambers which were in operation, to reach the chamber being defrosted. The pipes passing through these operating chambers were subjected to “constantly maintained” freezing temperatures. The “problem” of standing water freezing in these pipes existed in the Gayley installations in exactly the same way as in McAdam and was solved in the same way (York Br. pp. 27-28).

IIb. By Sale to Polar Ice Company at Indianapolis.

The defense here proven is not prior use but prior *sale* by Hayes Bros. Inc. to Polar Ice, of an installation which had all of the elements of McAdam’s claims and which was designed to operate and did operate at the time of sale in a space “*constantly maintained*” below freezing (York Br. pp. 28-36).

Refrigeration’s brief does not refer to any oral or documentary evidence which throws the slightest doubt upon the above, or upon the fact that the sale was made, or that the structure of the installation sold was as described by York in its brief, or that the unit was designed to operate and was operated by those who installed it to maintain constantly a below freezing temperature.

Refrigeration’s criticisms are directed to the condition of the installation, and to how the equipment was used, at a time *long after its installation* and shortly before the trial of this case. Obviously this has nothing to do with the situation at the time of sale. The conditions *at that time* are the only ones pertinent and as to those conditions there is no conflict of evidence.

Lacking refuting evidence, Refrigeration has attempted to confuse the issue by referring to Barton’s testimony that the installation was indelibly imprinted on his mind, because it was “such a headache and a source of so much trouble” (R. 418). The testimony conveniently omitted by Refrigeration was Mr. Barton’s statement that the “headaches” to which he was referring were the troubles en-

countered *before water defrosting was put in*. He testified (R. 429):

“203 Q. Was the job straightened out? A. Yes, sir.

204 Q. Were there any headaches or troubles thereafter? A. No sir. [547]

205 Q. How was it straightened out? A. It was straightened out by installing this water defrosting system to take the frost and ice off the coil.

206 Q. Did you have any complaints with respect to the operation of this unit during the period of inspection which you made after the installation was complete and paid for? A. No sir.”

Similarly, when Barton was quoted as stating that he “could not be conclusive as to maintaining below freezing conditions in the room” (Br. p. 36), Refrigeration’s brief failed to point out that Barton was not talking of the situation at the time of installation and sale but as of when the photographs (Pl. Exs. 18 and 19) were taken, shortly before the trial. With the deterioration that had taken place in the building since 1934, Barton naturally refused to give an opinion, since, as he stated, he did not know the present condition of the building with respect to moisture and insulation (R. 431).

Refrigeration states that the unit “was not self-draining” (Br. p. 36), but the only evidence cited to support this is based upon the condition of the unit at the time the depositions in this case were taken, years after installation, the unit in the intervening years having sagged, naturally shifting the inclination of the piping (R. 495). This has nothing to do with its condition at the time of installation and sale. The *only* evidence of its condition at that time is testimony that the piping was installed in such a manner that it would and did drain (Barton R. 411; Hayes R. 445, 464).

As to Simons stating that the water stuck in the line, Refrigeration did not point out that he also said that this was “before I learned how to defrost it right” (R. 491) and “before I learned how to operate the machine” (R. 495). But again, that has nothing to do with the condition at the time of sale.

Documentary evidence and corroborated testimony establish that this water defrosted unit, having the structure of the McAdam claims, was sold prior to his date of alleged invention and at the time of sale it was capable of maintaining and did maintain constantly a temperature below freezing. This constitutes a complete anticipation, even accepting Refrigeration's interpretation of the claims.

IIc. By the Prior Use of Swift & Company Installations at Elmira.

This prior use is completely covered in York's Main Brief pages 36 to 39.

The fact that the pickle room spray pipe once froze does not disprove that the installation was self-draining but only indicates that the installation may have once been improperly operated. The McAdam patent is for an *apparatus* and not a mode of operation. Both apparatus at Swift & Company have all of the physical elements of the McAdam apparatus and, as such, fully anticipate the patent.

IId. By the Prior Use at Yamhill.

Refrigeration argues (pages 41-50) that this prior use should not anticipate the patent because

(a) it was an unsatisfactory experiment and was abandoned:

(b) "it was not constantly maintained below the freezing point of water, and, hence, did not involve the McAdam invention" (p. 47); and

(c) involved "walls and vanes isolating the refrigerating unit, a defect which it is one of the objects of the McAdam invention to avoid" (p. 47).

This prior use is discussed at pages 39 to 49 of York's Main Brief.

(a) The evidence establishing that the installation was satisfactory and was not an abandoned experiment, is summarized on pages 45-49 of York's Main Brief and need not

be repeated here. It should be stated, however, that it is not a fact that none of those associated with the Yamhill installation ever intended to build another unit like it (Refrigeration Br. p. 45), for Postlewaite stated that he installed another water defrosting system at Glacier Bay Oyster Company at North Bend, Washington, and that the Yamhill unit was not the first one installed (R. 914).

(b) Again Refrigeration emphasizes that McAdam's invention involves "constantly maintaining" the refrigerated space below freezing. As we have pointed out in our Main Brief, McAdam's patent is not so limited (pp. 13-15) and if so limited, is not infringed by York (p. 68).

However, in the Yamhill installation the evidence is absolutely uncontradicted that the locker room was maintained at a below freezing temperature, and that the "little room" next to the locker room, in which the refrigerating unit was placed, was below freezing (York Br. pp. 43-45).

Postlewaite did not testify, as Refrigeration implies at page 45, that the "little room" was above freezing during defrosting. What he was asked was whether the temperature *inside of the refrigeration unit* was raised to the temperature of the water during defrosting and he replied (R. 891) "Well, no, I don't think so. It might have. I couldn't tell you that for sure." Obviously the temperature inside of the unit would have been raised slightly by the water defrosting, just as it was raised in Refrigeration's unit, as Refrigeration's own witness testified (R. 180-1).

(c) If Refrigeration contends that an installation which has the refrigerating unit outside of the insulated space but connected to it with ducts, for that reason is not an anticipation of the patent, then such a device cannot constitute an infringement of the patent. The claims do not require the refrigerating unit to be inside the refrigerated space but merely specify that it shall be "in combination with a refrigerated space". However, in the Yamhill installation the refrigerating unit, while outside of the locker room, is within the "little room" which was below freezing.

Whether there were doors or vanes in the air duct leading into the locker room and whether they were placed there to keep the defrosting water from splashing into the locker room as was testified (R. 936), is a matter of no consequence. The important consideration is that the Yamhill installation had each element of the apparatus specified in the McAdam claims in suit, irrespective of what other additional improvements it might have had.

Ile. The Wenzl and the Jensen & Roser Patents Anticipate.

Refrigeration's objection (pp. 50-55) to these patents is that neither teaches the use of water for defrosting "refrigerator coils located in a space required to be *constantly maintained* below" freezing.

Refrigeration's objection again emphasizes that it is attempting to import into apparatus claims a method of use, or function. Although it is stated specifically in the Wenzl patent that "the air is cooled to a temperature below 0° " (R. 1275, col. 1, lines 33-4) and in the Jensen & Roser patent that the temperature of the air leaving the refrigerating machine is not higher than -2° C. (28° F.) (R. 1282), Refrigeration argues that in order to anticipate, the patents must teach that the space is required to be "constantly maintained" below freezing. It is obviously ridiculous to contend that the prior devices must have been actually "constantly maintained" at a specific temperature in order to be anticipations. This imports a question of how the particular apparatus was operated. It is certainly enough if the apparatus has all the elements conforming to the physical elements required by the McAdam claims and is capable of operating in a temperature which is below freezing. Such a device is anticipatory whether or not the refrigerated space was actually "constantly maintained" below freezing.

The *Wenzl* patent clearly teaches the idea of using water from a spray pipe to defrost coils which are used to cool the air of a refrigerated space "to a temperature below 0° " (R. 1275). The patentee Wenzl did not consider it necessary to show the pipe connections to his spray head

or from his drain pan, since it was obvious that by using common plumbing practice (R. 430, 464) the pipes could be drained when the spray head was not in operation.

In the *Jensen & Roser* patent (R. 1279, 1286) the construction of the device is such that it obviously is intended to be placed within a refrigerated space the air of which is cooled to a temperature at least as cold as 4° F. below freezing. The whole defrosting operation was intended to take place in a sub-freezing atmosphere. The construction is entirely clear, despite the difficulties which Refrigeration tries to find with it. The spray head 16 placed above the container tube is stated to be “pierced with openings to permit the air or water to flow uniformly through the container *and its pipes and into its passages*” (R. 1282). Therefore, obviously the spray head 16 is pierced on the inner surface as well as underneath, so that water will be sprayed over the top of the container and through the pipes and passages which extend longitudinally through the container, as well as spraying over the outside of the container.

This French patent shows a device specifically adapted to be placed within a refrigerated space which is to be cooled to a temperature below freezing: the device is intended to be supplied with water which is brought into, sprayed in, and taken away through, a freezing atmosphere. The patent discloses an apparatus similar to McAdam: an inlet pipe leading to the spray pipe above the cooling unit for spraying water over the unit to melt the ice, a drip pan 14 and a discharge pipe 18. The only parts which it does not show are the usual plumbing connections outside of the refrigerated space to the water source. Inclining the piping so that it would drain and providing the usual valves for letting the water in and out, which is all that McAdam added to the structure of either of these patents, are certainly not within the realm of invention.

Refrigeration makes the statement (Br. pp. 23-24) that it was not obvious to use water in a space which was at a temperature “below the freezing point of water in the hope

of removing frozen water. There is indeed an element of daring in the suggestion". As stated above, both the Wenzl and Jensen & Roser patents specifically state that the air leaving the refrigerating coils, and therefore the coils themselves, are at a temperature below freezing. There is nothing novel, therefore, about the use of water to defrost at below freezing temperatures. These patentees found nothing "daring" in the suggestion, nor did the numerous witnesses who testified as to the prior uses.

McAdam was not the first to discover that water contained enough heat to melt ice which was in an atmosphere below freezing. Nor could he have obtained a patent for this had he been the first to discover it, for it is merely a function of nature. *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, — U. S. —, 76 U. S. P. Q. 280 (decided February 16, 1948). Nor was such a patent granted him. He was granted a patent for a specific apparatus, a combination of *physical* elements. Any prior art device having those physical elements anticipates his patent.

III. McAdam Patent Is for a Combination

There is certainly no doubt that the McAdam patent is for a combination. What Refrigeration does not make clear (p. 55) is that the claims of the patent are for a combination of *physical things* constituting a physical apparatus. One of those physical things is a refrigerated space. Whether that refrigerated space be "*constantly*" maintained at below freezing is not a part of a physical apparatus combination. It may be a method of operation, but is certainly not part of an apparatus, which is the kind of patent McAdam was granted. And the Patent Office specifically refused the inclusion of such an element in apparatus claims, to which refusal Refrigeration acquiesced (York Br., pp. 13-15). Refrigeration can not now claim that such a limitation is a part of the claims.

IV. York Does Not Infringe

Refrigeration has now categorically stated that the McAdam "claims are to be construed as limited to a refrigerated space constantly maintained below the freezing point of water" (Br. p. 60).

In order to prove infringement, it is necessary that Refrigeration prove that York made, used or sold not only the water defrosted unit defined in the claims, but also a "*refrigerated space*", and additionally that the refrigerated space was "*constantly*" maintained below freezing. Refrigeration specifically states that the claims are thus limited (Br. p. 60).

There is no proof that York has made, used or sold *any* refrigerated space, and no proof that any refrigerated space was maintained "*constantly*" below freezing.

The stipulation as to York's sales states that York "supplied water defrosting connections with its standard sectional coil unit, where the unit was installed to maintain a temperature well below freezing in the refrigerated space" (R. 1528). What York sold was the unit and connections, and *not* the space. There is no statement in the stipulation that the refrigerated space was made or sold by York. What York sold was something *less* than the patented combination, since it did not sell the refrigerated space which was an element of the combination, and an important one, for it is only by its limited interpretation of the term "*refrigerated space*" that Refrigeration claims to be able to distinguish the prior art. Having made and sold something *less* than the patented combination, York can not possibly have infringed.

Refrigeration's remarks on infringement (p. 57) would be somewhat more pertinent if the question were one of York's "*contributory* infringement". But that is not the issue here. The issue and charge is one of *direct* infringement and York has not directly infringed.

Refrigeration asserts its patent is for a combination including a refrigerated space constantly maintained below freezing. It seeks to distinguish all the prior art on that limited element. Clearly, therefore, Refrigeration must prove that York made, used or sold the combination including that element which is the asserted difference over the prior art. York did not in fact do so, and there is no proof in this case that it did.

York has not infringed any of the claims.

V. All the Claims in Suit Are Invalid.

Although Refrigeration does not now charge infringement of claims 3, 4, 9-11, 14 (Br. p. 57), the validity of all the claims of the patent is in issue.

The District Court was correct in its holding that claims 1 through 12 and 14 are invalid, but it should have also held invalid claim 13. They are all invalidated by the prior patents, prior sale and prior uses already discussed.

VI. Refrigeration Has Misused the Patent.

There is no doubt that Refrigeration has misused this patent (York Br. pp. 69-74). Refrigeration admits (p. 61) that it does not sell a hose or connections which form a portion of the supply and drain conduits. Its Manager, Jarvis, testified that what Refrigeration sold was "The complete package as you see it (referring to Defendant's physical exhibit GG) with the 3-way valve, fan, motor, housing, spray pan over the top and spray pan underneath" (R. 1099). There is no mention here of a refrigerated space. To sell less than the whole patented combination is to sell an unpatented product because "a patent on a combination is a patent on the assembled or functioning whole, not on the separate parts." *Mercoïd Corp. v. Honeywell Co.*, 320 U. S. 680, 684 (1944).

There is therefore evidence before the Court that Refrigeration is conducting its business in a manner which was condemned in the *Mercoild* cases, 320 U. S. 661 (1944), and 320 U. S. 680 (1944).

Respectfully submitted,

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